

REMARKS

The application contains claims 1-15. Support for new claims 14 and 15 can be found in the application as filed in "Synthesis Example 1" bridging pages 57 and 58 thereof.

This restriction requirement is traversed on multiple grounds: the statutory standard has not been met; the classification system does not support a restriction requirement; applicant has a right to define his invention; there is no serious search burden; applicant has paid for an examination of all claims; and in any case, discretion should be exercised and restriction not required.

The Statutory Restriction Standard Has Not been Met

The Patent statute states:

"If two or more independent and distinct inventions are claimed in one application, the Commissioner MAY require the application to be restricted to one of the inventions." (Emphasis supplied, 35 USC 121)

The standard requires that the allegedly multiple inventions be "independent and distinct". This standard has not been met. In support of the restriction the Examiner argues that "the product can be made by another process ..." (last office action; penultimate line; emphasis supplied). Assuming, for the sake of argument, that this is true, it follows that the product can be made by the claimed process. This means that they the product and process are not independent and distinct. The statutory standard has not been met.

Classification Does Not Support a Restriction Requirement

The patent statute states:

“The Commissioner may revise and maintain the classification by subject matter of United States letters patent, and such other patents and printed publications as may be necessary or practicable, for the purpose of determining with readiness and accuracy the novelty of inventions for which applications for patent are filed.” 35 USC 9

The classification system exists “... for the purpose of ... determining novelty ...” not to determine whether a claim defines multiple inventions which may or may not be independent and distinct.

The public has no right to be heard on the classification system. This means the Commissioner is completely free to define classes and subclasses as he see fit. Such independent authority is necessary to make the subclasses sufficiently small for easy searching, not to determine the presence or absence in a single case of multiple inventions.

Congress never intended to empower the Commissioner to develop a search classification system and then use that search system to determine the possible presence in a single case of multiple inventions.

Applicant Has a Right to Define His Invention

By requiring the restriction, applicants are deprived of their statutory rights under 35 USC 112 to have “claims particularly pointing out and distinctly claiming the subject matter which applicant regards as his invention.” (Emphasis supplied). The Examiner has, in effect,

carved out a portion of applicant's invention and rejected it under the guise of a restriction requirement under 35 USC 121. This the Commissioner may not do.

The Search Here Does Not Impose a Serious Burden

The Manual of Patent Examining Procedure ("MPEP") states:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. (MPEP Sec. 803 emphasis supplied)

There is no serious burden here. Assuming, for the sake of argument, that the Examiner has correctly characterized the subclasses that need be searched. This is only two subclasses. The Examiner has made no showing that a search of this number of subclasses is a "serious burden". The burden of proof to show "serious burden" is on the Examiner. This burden has not been met.

Applicant Has Paid for Examination of All Claims

Having paid an application fee, the applicant is entitled to have the Examiner determine the novelty and non-obviousness of the subject matter claimed. If this requires a search of three or more subclasses, so be it. If the position of the Examiner be accepted, applicants will be burdened with the expense of two additional applications. These expenses include government filing fees, issue fee and maintenance fees in addition to attorneys fees and the value of the time that the inventor will necessarily spend during prosecution.

Restriction is Discretionary

Even if the statutory standard has been met, discretion should be exercised in this case and restriction not required for the reasons given herein.

Provisional Election

A provisional election is made with traverse of the claims of Group I namely claims 1-5 inclusive. Notwithstanding this provisional election an action of all pending claims on the merits is respectfully requested. In the event that the claims of Group I are determined to be patentable over the prior art, the claims of Group II would automatically be patentable, so the Examiner is requested , at a minimum, to rejoin the claims of Group II once the claims of Group I are determined to be patentable.

Election of Species

In response to paragraph 2 on page 3 of the last office action the Examiner is informed that the compound called "Amine 2" on page 58 at about line 13 of the application as filed is a species within the scope of formula (2) appearing in claim 2 and elsewhere. The Examiner has assigned claim 8 to Group III, a group not provisionally elected. "Amine 2" is the subject of newly added compound claim 14. Presumably the Examiner would assign claim 14 to Group III. "Amine 2" is also the subject of newly added composition claim 15. Although claim 15 is dependent, it belongs to provisionally elected Group I.

Groups I and II should both be searched

In order to determine the novelty of composition claim 1, and the other claims of Group I, the Examiner may decide to search the novelty of the compounds of claim 1. Some of these compounds are claimed *per se* in the claims of Group III. The Examiner argues that claim 1 is in class 430, subclass 270.1; and that Claim 8 is in class 548, subclass 335.1+. Searching two subclasses is not a serious burden. Whatever, the position of the Examiner as to Group II, all claims of both Groups I and III should be examined.

Summary

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to telephone David R. Murphy (Reg. No. 22,751) at 703-205-8000; Extension 8053 to conduct an interview in an effort to expedite prosecution of this case.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By 

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